

## **REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### **Amendments to Claims**

Claims 1-9 stand cancelled without prejudice or disclaimer.

Claim 10, 16, 17, and 18 currently are being amended. No new matter is added by the amendments. Support for the phrases, “wherein the tab has a handle that is external to the pad,” and “the breakable connection is internal to the pad” in Claim 10, 17, and 18, can be found in the Figures 1-4 of the application as filed. Support for the phrase, “and causes separation of the tab from the applicator” or “and separating the tab from the applicator,” can be found on page 4, paragraph [0017] of the application as filed. Support for the term “handle” can be found on pages 3-4 paragraph [0015] of the application as filed. Support for claim 16 can be found, for example, on pages 3-4, paragraph [0015]; and page 4, paragraphs [0017] and [0019] of the application as filed. Entry of the amendments is respectfully requested.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 10-18 are now pending in this application.

### **Information Disclosure Statement (IDS)**

Applicants thank the Office for acknowledging the IDS filed on September 1, 2006.

**Election/Restriction**

Applicants request the Office to acknowledge the telephonic election of Group I, claims 10-16, by the Applicants. Per a telephonic Restriction Requirement on August 10, 2008, the Examiner advised that the claims be restricted into three groups:

Claims 10-16: directed to a device;

Claim 17: directed to a first method; and

Claim 18: directed to a second method.

The Examiner presented a telephonic restriction requirement which was responded to by Applicants on August 14, 2008 which response elected Group I, claims 10-16.

**Claim Rejections Under 35 U.S.C. § 102(b)**

Claims 10-12 and 16-18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Emerit et al. (WO 00/71198).

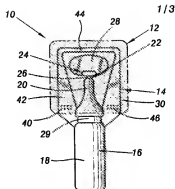
In order to be fully responsive to the Office Action, Applicants will respond to all of the rejected claims, claims 10-12, and 16-18.<sup>1</sup> Applicants traverse the rejection for the following reasons.

To anticipate a claim, a single source must contain all of the elements of the claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986).

Emerit et al. do not teach or suggest all the elements of the claimed invention. Emerit et al. teach an applicator where an entire tab including the neck **20**, axial exit **22**, stopper **24**, and **28** are within the absorbent plug **12**, as shown in Figure 1.

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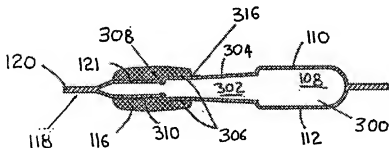
<sup>1</sup> As per above, this rejection is inconsistent with the election provided by Applicants on August 14<sup>th</sup>. Applicants request clarification as to whether the restriction requirement has been withdrawn or whether the rejection inadvertently included non-elected subject matter.



**FIG.1**

Therefore, when there is an angular displacement of **44** (page 3, ¶6 of Emerit et al.), stopper **24** is detached by shearing resulting in the detached portions remaining within the plug **12** (page 3, ¶9 of Emerit et al.).

This is in contrast to the claimed invention where the tab **118** comprises a handle portion **120** that is external to the pad **116** (for example, see Figures 1-4) such that when the breakable connection **308** is severed, tab **118** can be readily separated from the dispenser **100** by pulling stem **121** through channel **310** (for example, see Figure 3).



**FIG. 3**

Therefore, there is a separation of the severed portion from the applicator in the claimed invention as opposed to the severed portion remaining within the applicator, as in Emrit et al. In

order to expedite prosecution, Applicants have amended the claims to clarify this feature of the claimed invention.

In light of the absence of all claim elements in Emerit et al., withdrawal of this rejection is respectfully requested.

**Claim Rejections Under 35 U.S.C. § 103**

Claims 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Emerit et al. ('198) in view of Jonn et al. (U.S. Patent Publication No. 2002/0037310).

Applicants traverse the rejection for the following reasons:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For the same reasons as provided above, Applicants submit that Emerit et al. do not teach or suggest all the claim limitations. Further, Emerit et al. do not suggest or motivate a person of ordinary skill in the art to attach the breakable portion of the applicator external to the applicator since the breakable portion of the applicator is encased in the means of maintenance 14 (see for example, page 2, ¶12 of Emerit et al.) which means of maintenance 14 holds the absorbent plug 12 (see for example, page 2, ¶2 of Emerit et al.).

In fact, the device of Emerit et al. teaches away from the claimed applicator and provides for a device with several disadvantages. Specifically, the Emerit et al. device would necessitate breakage of the tab within the applicator wherein such breakage could lead to disruption of the applicator such as by tearing, ripping or forming channels within the applicator in such a manner

that the applicator's function is reduced or compromised. Nothing in this reference suggests that this issue can be obviated in the manner of the now claimed invention.

As to Jonn et al. (U.S. Patent Publication No. 2002/0037310), this reference fails to cure the deficiencies noted above for the Emerit et al. device as this reference is merely relied upon for inclusion of a tissue adhesive within the device.

In light of the reasons as provided above, withdrawal of this rejection under 35 U.S.C. §103(a) is respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

**CONCLUSION**

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 01/05/09

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